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Mailed: May 26, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Spirits Product International S.A.

Serial No. 78147137

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Before Walters, Chapman and Holtzman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On July 24, 2002, Spirits Product International S.A.
(a corporation of Switzerland) filed an application to
register on the Principal Register the mark SPI for
services amended to read "advertising and promotional
services, namely, rendering advice to others regarding food
and beverage advertising and sales promotion" in
International Class 35. The application is based on (i)
Section 1(b) of the Trademark Act, 15 U.S.C. §1051(a),
through applicant's assertion of a bona fide intention to

use the mark in commerce, and (ii) Sections 44(d) and (e), 15 U.S.C. §§1126(d) and (e) of the Trademark Act, through applicant's Benelux Registration No. 0709611 based on its Benelux application filed July 12, 2002.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark shown below



for "market analysis services, namely, gathering and evaluating information relating to the development of market strategies for businesses of others" in International Class 35,¹ that when applicant's mark is used in connection with its identified services, there is a likelihood of confusion, mistake or deception.

Applicant has appealed, and briefs have been filed. Applicant did not request an oral argument.

With its brief on the case, applicant submitted for the first time evidence in the form of printouts of pages from registrant's website (Exhibit 1) and typed references to some third-party registrations (p. 14). The Examining

¹ Registration No. 1156601 issued June 2, 1981, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed.

Attorney has properly objected to this evidence as untimely under Trademark Rule 2.142(d). The Examining Attorney's objection is sustained and the Board has not considered this untimely evidence.²

Turning to the merits, our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We consider first the marks. Applicant's mark SPI is virtually identical to the cited mark, SPI in stylized

² With specific regard to applicant's references to third-party registrations, typed reference to third-party registrations is not sufficient to make them of record. See *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, footnote 2 (TTAB 1998); and *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974). Also, third-party registrations do not establish that the marks shown therein are in use, much less that consumers are so familiar with them that they are able to distinguish among such marks.

lettering. The stylized lettering in registrant's mark is a minor difference and would not obviate any likelihood of confusion. See *Spoons Restaurants Inc. v. Morrison, Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992).

We find that applicant's mark is identical in sound and highly similar in appearance to the cited registration.

As to connotation and commercial impression, applicant contends that because Strategic Planning Institute, Inc. is registrant's corporate name, and the letters SPI are an abbreviation of descriptive terminology in registrant's case, the registered mark is weak and entitled to limited protection. Applicant further contends that "there are literally thousands of businesses in the United States using combinations of letters in their business names and service marks" (brief, p. 13) and "once customers realize that a mark is merely an abbreviation for a business name, there is a perception that the mark is merely an alternative for the name (as opposed to an arbitrary mark with independent significance.) Thus, many customers will flip-flop in their use of the business name and the abbreviation mark" (brief, p. 12); and that consumers will resist making purchasing decisions based on weak marks, such as letter combination marks.

Applicant's argument that SPI is descriptive in relation to registrant's services is not persuasive and it is an impermissible collateral attack on the cited registration. See *In re Dixie Restaurants Inc.*, supra, 41 USPQ2d at 1534; and *In re Peebles Inc.*, 23 USPQ2d 1795, footnote 5 (TTAB 1992).

Applicant's arguments regarding consumer perception of letter marks in general and these two SPI marks in particular are not supported by any evidence. That is, there is no evidence of record of any use by any party (including applicant, the cited registrant or any third-party) of any mark including the letters SPI for the involved services or any other goods or services, nor any evidence of how consumers would so perceive the marks.

Applicant's argument regarding the connotations of the two SPI marks is unavailing because registrant's corporate name is not part of the registered mark and, thus, any connotation of the mark as an acronym is not relevant to our consideration of the marks before us. Further, assuming *arguendo* that consumers may be aware of the parties' respective corporate names and further assuming that they will then attribute the letters "SPI" to refer to the separate corporate names, this would nonetheless not obviate the likelihood of confusion between

these letter marks using the identical three letters in the identical order.

We find that applicant's mark is identical in sound, appearance, connotation and overall commercial impression to the cited registered mark. See *Weiss Associates Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

Applicant has not established that the cited registered mark is a weak mark. Even if applicant had so established (which it did not), weak marks are nonetheless entitled to protection against registration by a subsequent user of the same or similar mark for the same or related goods or services. See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976).

Turning next to a consideration of the goods involved in this case, we start with the well-settled principle that goods or services need not be identical or even competitive to support a finding of likelihood of confusion. Rather, it is enough that the goods or services are related in some manner or that the circumstances surrounding their marketing are such that they would likely be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they emanate from or are in some way associated with

the same producer or that there is an association between the producers of each party's goods or services. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001); and *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992). Further, the question of likelihood of confusion in Board proceedings regarding the registrability of marks, must be determined based on an analysis of the goods or services identified in applicant's application vis-a-vis the goods or services recited in the registration. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case, the registered mark is for "market analysis services, namely, gathering and evaluating information relating to the development of market strategies for businesses of others," while applicant intends to offer "advertising and promotional services, namely, rendering advice to others regarding food and beverage advertising and sales promotion."

Applicant argues, inter alia, that its identified services are limited to the food and beverage industries, while registrant's identification of services uses vague

terminology such as "market analysis services" and "relating to"; that registrant analyzes markets and businesses across all sectors (i.e., at a broad level) and registrant merely supplies information about what is going on in various industries, while applicant distributes alcoholic beverages and provides highly tailored specific advertising and promotional advice to its distributors in a narrow market segment.

As the Examining Attorney correctly argues, even though applicant's advertising and promotional services are limited to the food and beverage industries, registrant's "market analysis services..." are not so limited and thus registrant's services include such services for the food and beverage industries. Moreover, applicant's arguments (unsupported by evidence) regarding registrant simply offering data to general business segments is not relevant as there are no such limitations in registrant's identification of services. As explained previously, the Board must decide the issue of registrability on the basis of the identifications of services in the cited registration and the application.

In support of the refusal to register, and particularly the relatedness of the respective services, the Examining Attorney has submitted copies of several

representative third-party registrations, based on use in commerce, indicating the same entities offer marketing services and advertising services/advertising consulting services under the same mark. See, for example, the following:

Registration No. 2721452 for, inter alia, "advertising agencies, namely, promoting the services of businesses through the distribution of printed, audio, and video promotional materials and by rendering sales promotion advice, providing advertising space in periodicals, creating corporate logos and brand identity, for others; business marketing and direct mail consulting services, and merchandising display services, for others";

Registration No. 2481090 for, inter alia, "advertising and business management services, namely, marketing consulting services, updating and dissemination of advertising material, conducting marketing research and studies; business management and business organization consulting, namely, expert advice on how to implement a marketing strategy and how to backup and support that strategy; business management in the area of advertising; ... ";

Registration No. 2300224 for, inter alia, "market analysis; market research; business research and surveys; conducting business and market research; conducting marketing studies; business management and consultation; demographic consultation; management consultation in the fields of advertising and media communications;...";

Registration No. 2296586 for, inter alia, "advertising agency services, namely, promoting the goods and services of others; market analysis; market research, business research and surveys, conducting business and market research; conducting marketing studies; business management and consultation; ... management consultation in the fields of advertising and media communications; ... ";

Registration No. 2653057 for, inter alia, "advertising agencies; ... conducting business and marketing research and studies; ... market analysis and research; ... developing promotional campaigns for businesses; product merchandising services; consultation in the fields of advertising, marketing and product merchandising; ... ";

Registration No. 2513197 for, inter alia, "advertising agencies; market research; market analysis; business consultation in the fields of advertising, marketing, product branding and product promotion; ..." ;
and

Registration No. 2791800 for, inter alia, "marketing, namely, promoting the goods and services of others through the provision of customized advertising in print, displays, and electronic media, market research; market analysis; benchmark analysis, namely conducting studies for others regarding best business practices; business consultation in the fields of advertising and marketing, product branding and product promotion; ... providing comprehensive business management and consultation to clients to help clients manage their resources most effectively; business marketing consulting services in the field of

competitive market analysis and
strategy analysis, conducting marketing
surveys and studies."

When considering the third-party registrations submitted by the Examining Attorney, we remain mindful that such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them. Such third-party registrations nevertheless have some probative value to the extent they may serve to suggest that such services are of a type which emanate from the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, footnote 6 (TTAB 1988). Thus, the third-party registrations submitted by the Examining Attorney are evidence of the relatedness of the respective services in that they show that consumers may well expect applicant's advertising and promotional services and registrant's market analysis services to emanate from a single source. That is, applicant's identified services and the services listed in the cited registration are likely to be perceived as related in the mind of the consuming public as to origin. See *Hewlett-Packard Company v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) ("even if the goods and services in question are not identical, the consuming public may

perceive them as related enough to cause confusion about the source or origin of the goods and services"); and *Recot Inc. v. M.C. Becton*, 214 F.3d 1332, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("even if the goods [or services] in question are different from, and thus not related to, one another in kind, the same goods [or services] can be related in the mind of the consuming public as to the origin of the goods [or services]. It is this sense of relatedness that matters in the likelihood of confusion analysis.").

We find that applicant's advertising and promotional services and registrant's market analysis services are related.³

Applicant argues that the channels of trade are different because, for example, registrant offers its services online through an Internet website but applicant "does not provide services through online interaction with a database." (Brief, p. 18.) While applicant's services are limited to the food and beverage industries, there are no specific limitations on trade channels through which applicant's services could be offered. Therefore, this

³ Applicant's arguments to the contrary are not supported by rebuttal evidence. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir.) (The issue in the case was mere descriptiveness, but the Court discussed an applicant's burden of coming forward with evidence in support of its arguments.)

argument by applicant is irrelevant and unpersuasive. See Octocom v. Houston, supra.

We find that the respective services, as identified, could be offered through the same or at least overlapping channels of trade.

Applicant argues that "the respective services involved for both parties are marketed to experienced business persons and corporate executives who are highly knowledgeable about the services they are seeking" and that "the prospective purchasers of these services will always give careful consideration to the identity of the service provider, because, despite the dissimilarity of [the] services, both businesses involve an ongoing contractual relationship (as opposed to a simple impulse buy)"; and that applicant's purchasers "are almost exclusively highly specialized beverage and food distribution businesses that already have pre-existing contractual relationships with Applicant." (Brief, pp. 20-21.)

Again, there are no limitations in registrant's identification of services as to purchasers, and to the extent that applicant's identification limits purchasers to those in the food and beverage industries, purchasers in those two particular industries are encompassed within

registrant's identified services. Thus, we must find that the classes of purchasers are at least overlapping.

Assuming arguendo that these advertising and market analysis services are purchased with care by experienced and knowledgeable business people, these purchasers are not immune from confusion as to the source of services, particularly when they are sold under virtually identical marks. See *Wincharger Corporation v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); and *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

Suffice it to say that the facts in *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992), heavily relied on by applicant, are readily distinguishable from those in this ex parte appeal.

In view of the virtually identical marks, the relatedness of the services, and the same or overlapping channels of trade and purchasers, we find that applicant's mark SPI, if used by applicant, for its identified services is likely to cause confusion with the registered mark SPI (stylized lettering) for market analysis services.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.